

R E M A R K S

The title is amended. No new matter is introduced. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated September 9, 2004, (referred to hereinafter as "office action") the examiner objected to the drawings under 37 CFR 1.83(a) for the reasons specified in section 2 of the office action. The examiner objected to the title of the invention for the reasons specified in section 3 of the office action. The examiner rejected claims 1-4, 11-16, and 23-26 under 35 U.S.C. § 102(e) as being anticipated by Tadokoro, et al., U.S. Patent No. 6,166,877 (Tadokoro). The examiner rejected claims 5, 6-10, and 17-22 under 35 U.S.C. §103(a) as being unpatentable over Tadokoro.

Re the Objections to the Drawings:

The examiner objected to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. These rejections are improper in that the drawings do, indeed show the features that the examiner contends are absent. To the extent the drawings fail to show the 5<sup>th</sup> gear rack, that gear rack need not be shown where, as here, the disclosure of the other gear racks provide sufficient disclosure of the invention to allow a person having ordinary skill in the art to understand the subject matter of the claimed invention.

In addition, applicants note that the pending application is identical to the parent application, U.S. patent application serial no. 09/337,802. No objections to the drawings were ever made in that application. The failure of the Patent Office to object to the same drawings in the parent application is additional evidence that the drawings are sufficient under 37 CFR 1.83(a). Nevertheless, applicants respond to the drawing objections as follows.

The office action sets forth objections to the drawings contending that the "third bearing" of claim 5 and the "5<sup>th</sup>, 6<sup>th</sup>,

7<sup>th</sup> and 8<sup>th</sup> elongate gear racks" of claims 9 and 10 are not shown in the drawings. However, and quite to the contrary of this contention, the drawings, as filed, show a structure of a "third bearing" in the "roller 60" in Figure 3; and the drawings, as filed, also show structures representative of the "5<sup>th</sup>, 6<sup>th</sup>, 7<sup>th</sup> and 8<sup>th</sup> elongate gear racks" in the "additional gear racks 122', 136', and 138'" of Figure 4, as well as in the correspondence thereof to the gear racks 20, 22, 36 and 38 of the primarily-described embodiment of Figures 1-3.

It is not required that the specification literally describe the elements in the manner claimed, rather,

"[i]t should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification."

MPEP 1302.01, General Review of Disclosure (emphasis in the original).

More to the current point, in the case of *In re Hayes Microcomputer Products, Inc. Patent Litigation*, 982 F.2d 1527, 25 USPQ2d 1247 (Fed. Cir. 1992), the Federal Circuit addressed a sufficiency of the drawings challenge by noting there that "the drawings were sufficient for a skilled artisan to understand the subject matter of the claimed invention." Thus, sufficiency of the drawings question is the same as the specification section 112 questions. That is, they must be sufficient for a person having ordinary skill in the art to understand the invention.

In the present case, a person having ordinary skill in the art will sufficiently understand that the "third bearing" is taught by and/or includes the "roller 60" as well as alternative "sliding bearings" (as these are inherently understood and/or as they specifically identified as such in Applicants' paragraph

0043). Moreover, similarly well-understood is the support of the "5<sup>th</sup>, 6<sup>th</sup>, 7<sup>th</sup> and 8<sup>th</sup> elongate gear racks" by the "additional gear racks 122', 136', and 138'" of Figure 4, as well as in the correspondence thereof to the gear racks 20, 22, 36 and 38 of the primarily-described embodiment of Figures 1-3.

Lastly, on the unshown quality of one of the additional gear racks, i.e., the "5<sup>th</sup>" such additional gear rack, MPEP 608.02(f) provides the appropriate guidance, in noting that although "modifications described must be illustrated, . . . [t]his requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts" (emphasis added). Here, in view of the very full disclosure of gear racks, including the first through fourth as well as the sixth through eighth "additional" gear racks, a person having ordinary skill in the art will find the fifth gear rack both, but a minor variation thereof and by this point a well-known component part, and thus not a modification needing illustration.

As a result, the drawings show every feature of the invention specified in the claims (see e.g., claims 5, 6, 9, 10, 17, 18, 21 and 22), and the drawings are thus fully compliant with 37 C.F.R. §1.83(a). The objections to the drawings are thus traversed and should be withdrawn.

Re the Objections to the Title:

The examiner objected to the title as not being descriptive of the invention. Applicants respectfully disagree. However, in order to more rapidly resolve the issue, applicants have amended the title of the invention. It is believed that the amended title overcomes the examiner's objections.

In addition, applicants note that the title of the present invention is identical to the title of the parent application, U.S. patent application serial number 09/337,802. The failure of the Patent Office to object to the title in that application is additional evidence that the title, as originally filed, is sufficiently descriptive of the invention.

Re the Anticipation Rejections:

The examiner rejected claims 1-4, 11-16, and 23-26 under Section 102(e) as being anticipated by Tadokoro. These rejections are improper in that the Board reversed substantially the same rejections in the parent application. Therefore, claims 1-4, 11-16, and 23-26 cannot be anticipated by Tadokoro.

The parent patent application (i.e., U.S. patent application serial no. 09/337,802) was appealed to the Board of Patent Appeals and Interferences on August 8, 2003 (Appeal No. 2003-0988). The claims appealed were 1 and 3-24. In a decision issued on July 24, 2003, (Appeal No. 2003-0988) the Board reversed the rejections of claims 3-7, 12, and 16-19. The Board affirmed the rejections of claims 1, 13-15, and 24. Therefore, after the Board's decision, claims 3-12 and 16-23 stood allowable, pending resolution of a provisional double patenting rejection.

The claims of the pending application are basically identical to the claims in the parent application that were appealed and found by the Board to be allowable over Tadokoro. More specifically, claims 1 and 3-24 correspond to pending claims 1-23 of this application, with the exception that the term "integral" in claims 1, 12, and 23 is replaced by the term "formed as a single unit." Because the Board in the parent application found claims 3-12 and 16-23 to be not anticipated by Tadokoro, claims 2-11 and 16-22 of the pending application cannot be anticipated by Tadokoro.

The remaining claims rejected under Section 102, i.e., claims 1, 12-14, and 23-26 which were not found allowable by the Board in the parent application are not anticipated by Tadokoro because Tadokoro fails to disclose a first elongate guide unit that is formed as a single unit.

In the decision of the Board in the parent application, the Board sustained the examiner's 102 rejections of claims 1, 13-15, and 24 (corresponding to pending claims 1, 12-14, and 23), because the Board found reasonable the examiner's interpretation

of the term integral as encompassing Tadokoro's multi-piece construction. Specifically, the Board found it reasonable to interpret "the term "integral" to cover more than a unitary construction." See page 7 of the Board's decision. Therefore, in the opinion of the Board, claims 1, 13-15, and 24 were not allowable over Tadokoro because the term "integral" as used in those claims was regarded as including "more than a unitary construction."

Pending claims 1, 12-14, and 23 use the term "formed as a single unit" instead of "integral" in order to place the claims in a form that would be allowable by the Board, i.e., to use terminology to make clear that the claims do not cover "more than a unitary construction."

Because the term "formed as a single unit" cannot reasonably encompass more than a unitary construction, and because Tadokoro fails to disclose unitary construction, claims 1, 12-14, and 23 cannot be anticipated by Tadokoro.

Applicants' note that the current rejections are based on the assertion by the examiner that "unit" can include a group. See, for example, section 5, page 3 of the office action. This construction is unreasonable in light of the express statements made by the applicants and is unlawful under the rule in *Serrano v. Telular Corp.*, 111 F3d 1578, 42 USPQ2d 1538 (Fed. Cir. 1997). In *Serrano*, the Court of Appeals for the Federal Circuit ruled that the inventor's definition and explanation of the meaning of a word, as evidenced by the specification, controls the interpretation of that claim term, even over a dictionary definition. The examiner's reliance on a dictionary definition of the term "formed as a single unit" to mean something other than the meaning assigned to it by the inventors is contrary to *Serrano*, and cannot be used to support the examiner's rejections.

In addition, in attempting to rewrite the term "unit" to include a group, the examiner is effectively denying the applicants the ability to distinguish their invention over the prior art. Applicants first attempted to distinguish their

invention over Tadokoro by using the term "integral." The examiner took the position that integral could mean more than one piece, despite applicants' assertion that integral was to be construed as meaning a single piece and despite case law specifically construing the term "integral" to mean a single piece. Now, the examiner attempts to further rob the applicants of the ability to distinguish their claims by saying that the term "formed as a single unit" can mean a group. Applicants' assert that such a re-definition is repugnant to the meaning of the term and is thus unreasonable as a matter of law.

Claims 24-26 are new to the present application and were not considered by the Board in the appeal for the parent application. However, claims 24-26 are allowable for the same reason as claims 1-23. That is, claims 24-26 specifically contemplate that the first and second guide members are formed as a single unit with the first and second gear racks, respectively. For example, claims 24 and 25 state ". . . said first elongate gear rack defining a first elongate guide member. . ." Thus, the first elongate guide member is "defined" by the first elongate gear rack, which is another way of saying that the first elongate gear rack and first elongate guide member are formed as a single unit. Tadokoro's gear rack does not define an elongate guide member. Instead, Tadokoro's elongate guide member comprises a separate piece. Thus, Tadokoro cannot anticipate claims 24 and 25.

Claim 26 is also not anticipated by Tadokoro. Claim 26 states ". . . said guide means also defining an integral elongate gear rack. . ." Again, the fact that the guide means defines an integral elongate gear rack means that the two elements are formed as a single unit. Tadokoro's guide member does not define a gear rack: Tadokoro utilizes a separate gear rack. Therefore, Tadokoro cannot anticipate claim 26.

Re the Obviousness Rejections:

The examiner rejected claims 5-10 and 17-22 under 35 U.S.C. §103(a) as being obvious over Tadokoro. These rejections are

improper in that Tadokoro fails to provide any teaching or suggestion that would motivate a person having ordinary skill in the art and with no knowledge of the present invention, to modify the Tadokoro device in the manner required by the pending claims.

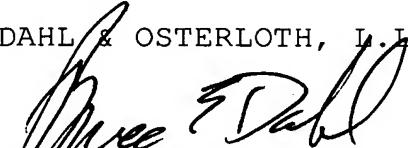
As already described, claims 5-10 and 17-22 each require (by virtue of their dependencies from independent claims 1 and 12) at least that the first guide member be formed as a single unit with the first elongate gear rack. The examiner has not identified any teaching in Tadokoro that would provide the suggestion or incentive required to meet this limitation. Therefore, even if it would be obvious to modify Tadokoro in the manner required by the various dependent claims (i.e., 5, 6, and 17-22), the resulting device would still fail to meet this underlying limitation. With regard to dependent claims 8-10, which depend from independent claim 7, the Board reversed the rejections of claim 8 (which corresponds to pending independent claim 7), finding claim 8 (thus pending claim 7) to be not anticipated by Tadokoro. Thus, dependent claims 8-10 are not prima-facie obvious over Tadokoro because the examiner has failed to demonstrate that the resulting device would meet the limitations of claim 7. In summation, then, claims 5-10 and 17-22 are not prima-facie obvious over Tadokoro.

Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues

remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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